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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MARTINE & PENILLA, LLP 710 LAKEWAY DRIVE SUITE 170 SUNNYVALE, CA 94085			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,822

Applicant(s)

KINZHALIN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/3/2004 has been entered.

Claims Status

Claims 2, 10 and 16 are canceled. Claims 1, 3-9, 11-15 and 17-20 are pending. Claims 1, 3-9, 11-15 and 17-20 are rejected in this office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-9, 11-15 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "providing a plurality of classes, each class capable of performing a particular task related to obtaining information from a specification, wherein the plurality of

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classes includes a get assertion class.” The specification does not contain a full, clear and concise written description of the manner and process of making a class which extracts an element of information from the specification. Paragraph 63 of the specification states the following:

Statements are considered testable assertions if they are intended to describe behavior of an API that can be tested by the TCK. Also, examples or sample code pieces that are provided in the specification are typically testable and can be verified by the TCK. In this sense, examples or sample code are generally considered testable assertions. Further, it should be noted that some assertions can be implied or indirectly stated in the specification, and these should be identified as well for testing. Note that an implied assertion might also introduce a specification flaw that may not be obvious.

The following vague and abbreviated language from paragraph 63 of the specification does not enable a skilled artisan to make and use the invention, for example, (1) statements are considered testable assertions [....] that can be tested by the TCK (technology compatibility kit), in particular, the technology compatibility kit is not enabled, (2) examples or sample code pieces are typically testable, (3) examples or sample code are generally considered testable assertions, (4) some assertions can be implied or indirectly stated in the specification, and (5) an implied assertion might introduce a specification flaw that may not be obvious.

Furthermore, the following vague and general language from paragraph 15 of the specification does not enable a skilled artisan to make and use the invention:

0015] Broadly speaking, the present invention fills these needs by providing a system for tracking a specification that automatically obtains assertions within the specification. The embodiments of the present invention further provide tracking between different versions of a specification, and also determine test coverage of a specification. In one embodiment, a method for collecting information on a specification of a computer program is disclosed. A plurality of classes is provided, where each class is capable of performing a particular task related to obtaining information from a specification. Then a command is received from a

user. The command requests a particular task to be performed. A class is then selected from the plurality of classes based on the task requested by the received command, and the selected class is run. In this manner, information on the specification is obtained. The plurality of classes can include a get assertion class that obtains assertions from the specification, and in some embodiments, the get assertion class can be used to obtain a list of assertions from the specification. The plurality of classes can also include a reporting class that provides information on test coverage of the specification. The information on test coverage of the specification can comprise a list of assertions that are tested by specification tests, and optionally, can comprise a percentage of the assertions obtained from the specification that are tested by specification tests.

Given the above explained lack of enablement of the classes that provide information, the “get assertion” class is even more difficult to manufacture because it is merely a typical instance of a plurality of instances.

Claims 5 and 18 recite “wherein the plurality of classes includes a reporting class that provides information on test coverage of the specification.” The specification does not contain a full, clear and concise written description of the manner and process of making a “reporting class” such that a skilled artisan can make and use the invention. It is unclear how a “reporting class” extracts information from the specification and how, if at all, the reporting class differs from the classes (including the get assertion class) which extract information from the specification.

Claim 9 recites “a code segment that filters the identified context prior to parsing the context.” The specification does not contain a full, clear and concise written description of the manner and process of (1) identifying a context, (2) filtering the context, and (3) after filtering, parsing the context. Furthermore, the purpose of such filtering and parsing is not obtainable from the specification.

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Claims 3, 4, 6, 7, 11-14, 17, 19 and 20 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-9, 11-15 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "providing a plurality of classes each class capable of performing a particular task related to obtaining information from a specification, wherein the plurality of classes includes a get assertion class that obtains assertions from the specification;

Paragraph 15 of the specification includes, "The information on test coverage of the specification can comprise a list of assertions that are tested by specification tests, and optionally, can comprise a percentage of the assertions obtained from the specification that are tested by specification tests." The definition of assertion as is well-known in the art is a Boolean statement used in a program to test a condition that, if the program is operating correctly, should always be true.¹ The scope of the invention is difficult to determine because it is unclear whether assertion as it appears in instant application is a Boolean statement that is used for debugging computer programs. As best examiner is able to ascertain, Applicant defines assertion as a testable statement within a specification. For purposes of this examination, examiner assumes that assertion is a statement within a specification.

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Claims 8 and 15 include language similar to above claim 1 and thus are rejected for the same reasons. Claims 3, 4, 6, 7, 11-14 and 17-20 are rejected for being dependent from a rejected base claim.

Art Rejection Precluded

Claims 5-7, 9, 11-14 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. No art rejection is provided in this office action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, 8, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,954,826 issued to Herman et al (hereafter Herman), as best examiner is able to ascertain.

Claims 1, 8 and 15:

Herman discloses a method for collecting information on a specification [col 1, lines 30-45] for a computer program, comprising the operations of:

¹ Microsoft Computer Dictionary, Fifth Edition

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- providing a plurality of classes [*class is the name for Java program files, col 4, lines 63-64*], each class capable of performing a particular task related to obtaining information from a specification, wherein the plurality of classes includes a get assertion class [*program code is extracted from files, col 2, lines 51-55*] that obtains assertions from the specification;
- receiving a command from a user, the command requesting a particular task to be performed [*user selection tabs, Fig 1, 115a, 115b, 115c, and 115d*],
- selecting a class from the plurality of classes based on the task requested by the received command [*analyze classes button 440, Fig 4*]
- running the selected class [*user initiates the data analysis per col 4, line 62-col 5, line 6*], whereby information on the specification is obtained

Claims 3 and 17:

Herman discloses the operation of obtaining a list of assertions from the specification using the get assertion class [Fig 4]

Claim 4:

Herman discloses determining whether each assertion in the list of assertions is a valid assertion [Fig 4]

Response to Arguments

Applicant's arguments filed 8/3/2004 have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states the following in the third paragraph on page 6 "The amended claims, made for clarification, recite features not disclosed by individual references to Herman et al, Mehring or DeLong et al. The references do not disclose a get assertion class that obtains assertions from a specification. Further, among other feature differences, Herman et al does not teach providing a plurality of classes such that each class is capable of performing a particular task related to obtaining information from a specification. Additionally, Mehring does not teach a computer program for obtaining assertions from a specification for a computer program such that a code segment parses the identified context to obtain assertions.

First Examiner Response:

Examiner is not persuaded. The rejections over Mehring and DeLong et al have been withdrawn to simplify the prior art considerations. The above comments by Applicant with respect to Herman et al will be considered in detail, as best examiner is able to ascertain. The following disclosure by Herman, col 2, lines 28-36, reads on "providing a plurality of classes, each class capable of performing a particular task related to obtaining information from a specification, wherein the plurality of classes includes a get assertion class that obtains assertions from the specification."

The embodiment of FIG. 1 compares user selected program files with user selected operating specifications and informs the user of the degree of compatibility between the two. The operation of the program is described in copending US patent application Ser. No. 08/939,756 for Method and Apparatus for Assessing Compatibility Between Platforms and Applications filed on Sept 29, 1997, and incorporated by reference herein.

Examiner maintains Herman reads on above claim limitation because Herman discloses that a program file is compared to a specification and thus "obtaining information from a

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specification” is inherent in the above disclosure by Herman because the information of the specification is compared with the information of the program file.

Other Applicant Arguments:

On pages 6-9 Applicant argues that Buxton, Golshani, Gramlich, Schaffer do not correct the alleged deficiencies of Herman as considered above. Examiner, is not persuaded, but has withdrawn the rejections in view of the other cited art besides Herman in order to simplify issues for appeal. Furthermore, Examiner draws attention to the following sections from the MPEP.

MPEP § 2106. II.C Review the Claims:

Office personnel must rely on the applicant’s disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff’d*, U.S. 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”).

Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPAQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 13201322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow

Applicant does not particularly point to the specification for an explicit definition of the term “get assertion class” and thus Examiner gives supra claim limitation its broadest reasonable interpretation. However, Examiner wishes to point out that Applicant uses the term “get assertion class” in a way that is not well-known in the art. Assertion per the accepted definition in the art is a Boolean statement that is used in a program to test a condition that, if the program

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is operating correctly, should always evaluate as true; otherwise the program will typically terminate with an appropriate error message. Assertions are used for debugging programs and for documenting how a program should work. It appears that in instant application, an assertion is merely some means of obtaining information from a specification. Applicant states in the specification that such information may comprise an element as simple as a sentence. Examiner maintains that there are many other well-known means for identifying a sentence in a document such as a specification.

Furthermore, Examiner mentions that comments provided by Applicant do not comply with Rule 37CFR 1.111(b) which requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964). Applicant merely asserts that the cited prior art does not read on the claimed invention without providing any arguments or evidence. Such assertions do not advance prosecution because Examiner has no recourse but to give claims their broadest reasonable interpretation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Etienne LeRoux

10/29/2004



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